

REMARKS

In the Office Action mailed July 26, 2010, the Examiner noted that claims 17, 18, 21-28, 30 and 32 were pending in the application; allowed claims 30 and 32; objected to claim 27; and rejected claims 17, 18, 21-26 and 28 on the ground of nonstatutory obviousness-type double patenting over claims 1 and 2 of U.S. Patent No. 7,328,034 to Costa et al. in view of "Applicants' Admitted Prior Art" ("AAPA") and U.S. Patent No. 6,771,628 to Söderkvist et al. This rejection is traversed below.

It is submitted that the nonstatutory obviousness-type double patenting rejection is improper. As noted in item 3 of the July 26, 2010 Office Action, a

nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

(Office Action, page 2, lines 20-24). Since the "AAPA" and Söderkvist et al. have been combined with claims 1 and 2 of the '034 patent, the Examiner has acknowledged that the rejected claims are not anticipated by claims 1 and 2 of the '034 patent. Therefore, the issue is whether the rejected claims are "obvious over" claims 1 and 2 of the '034 patent.

It is submitted that the inclusion of the words "obvious over" in the quotation above does not mean that what is taught by a prior art reference can be combined with the claims of a patent in a nonstatutory obviousness-type double patenting rejection. Rather, *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998) and the other cases cited in the Office Action have held that a nonstatutory obviousness-type double patenting rejection is proper only when an application "claim is not patentably distinct from the ... [patented] claim(s) ..." To meet this test, the difference between the application claim(s) and the patent claim(s) must be no more than an obvious and relatively minor variation.

At page 4, lines 12-14 of the July 26, 2010 Office Action, it was acknowledged that claims 1 and 2 of the '034 patent do not recite "employing timeslots of commonly assigned carrier frequencies as radio transmission resources, wherein at least two adjacent base stations simultaneously and jointly employ a timeslot of a carrier frequency for radio provisioning a respectively assigned mobile station" (claim 17, lines 13-15) or "selecting the timeslot from the commonly assigned radio transmission resources taking account of an interference situation in the timeslot" (claim 17, lines 16-17). These are significantly different limitations from what is recited in claims 1 and 2 of the '034 patent. Thus, claim 17 is "patentably distinct" from the '034

patent claims. Unlike a rejection under 35 U.S.C. § 103(a), the issue is not whether it would be obvious to combine teachings from another reference, like Söderkvist et al. or to use knowledge in the art described in the Background of the Invention of the application, but rather whether a method that includes the operations recited on the last 5 lines of claim 17 is so close to what is recited in claims 1 and 2 of the '034 patent that it would be obvious from the '034 patent to make the modifications.

The reasons given in the July 26, 2010 Office Action for combining the "APAA" and the teachings of Söderkvist et al. with claims 1 and 2 of the '034 patent were "increasing the data rate and conserving resources in a wireless network" (Office Action, page 5, lines 10-11) and "providing improved communication quality among mobile stations in adjacent/adjoining cells" (Office Action, page 6, lines 2-3). However, the objects of the '034 patent are "a synchronization method with a low level of complexity for a radio communication system with a cellular structure" (column 1, lines 61-63) allowing "synchronization to be achieved in respect of time and/or frequency in a cellular radio communication system in a simple manner with the aid of pilot signals" (column 1, lines 64-67), resulting in a "high signal-to-noise ratio allowing the receive-side evaluation of pilot signals for synchronization purposes to take place, even if the receive conditions are unfavorable" (column 2, lines 18-21) and making it "possible to weight the synchronization value estimation in respect of the radio cells, so that even weakly received mobile station and base station signals are taken into account" (column 2, lines 32-35). There is no suggestion in these objects and no suggestion has been found elsewhere that claims 1 and 2 of the '034 patent should be used for "increasing the data rate and conserving resources in a wireless network" or "providing improved communication quality among mobile stations in adjacent/adjoining cells." Thus, it is submitted that claim 17 is "patentably distinct" from claims 1 and 2 of the '034 patent.

For the above reasons, withdrawal of the nonstatutory obviousness-type double patenting rejection of claim 17 is respectfully requested. As claims 18 and 21-26 depend from claim 17, withdrawal of the rejection of claims 18 and 21-26 is likewise requested.

Claim 28 of the application was rejected for nonstatutory obviousness-type double patenting based on claim 18 of the '034 patent in light of the "APAA" and Söderkvist et al. The rejection of claim 28 acknowledged that claim 18 did not recite "utilizing time slots of jointly assigned carrier frequencies of an adjacent base station as radio transmission resources wherein the base station and the adjacent base station simultaneously and jointly employ a time slot of a carrier frequency for radio provisioning of a mobile station" or "selecting the timeslot

from the commonly assigned radio transmission resources taking account of an interference situation in the timeslot.” As in the case of claim 17, the description in the “APAA” and the teachings of Söderkvist et al. were relied on in the assertion that claim 28 of the application was not patentably distinct from claim 18 of the ‘034 patent. For the reasons discussed above with respect to claim 17, it is submitted that the nonstatutory obviousness-type double patenting rejection of claim 28 is improper and withdrawal of this rejection is respectfully requested.

Summary

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 17, 18, and 21-28, in addition to claims 30 and 32, are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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